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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,389	02/02/2000	Boris V. Marchegiani	11305/1	6138

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/496,389

Applicant(s)

MARCHEGANI, BORIS V.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-36 are pending. Applicants' change of address filed 05/03/01 has been entered as paper no. 5 and the IDS submitted on 05/19/00 entered as paper no. 4 and 8/20/01 entered as paper no. 6 has been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "tender" in claims 1, 5, 7, 11, 14, 17, 18, 20, 25-27, 30-32, 35, and 36 is used by the claims to mean, it is unclear what Applicant means in the claims, while the accepted meaning is (1) "to submit a formal bid to buy a security, as in a U.S Treasury bill auction or (2) offer of money or goods in settlement of a prior debt or claim, as in the delivery of goods on the due date of a *Futures Contract* or (3) agreed upon medium for the settlement of financial transactions, such as U.S. currency, which is labeled "legal tender for all debts, public and private."

3. It is not understood by the Examiner from reading Applicants' Specification and drawings what Applicants' mean by "tender".

For examination purposes, the Examiner will assume the Applicants' mean to submit a formal bid to buy a security, as in a U.S Treasury bill auction (a commodity, as in an auction). Applicants' are requested to clarify this term in the claim language and in Applicants' Specification.

Claims 7, 14, 18, 27, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites, "wherein the processing device enables a user to at least one of request and generate an exception to at least one of create and modify a term of the at least one tender". This claim limitation is confusing to the Examiner. Do Applicants' mean "the processing device enables a user to request and to generate an exception to the creation and modification of a term of the tender"?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-4, 12, 13, 17, 26, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,285,383) Lindsey et al, hereafter Lindsey.

As per claims 1, 17, 26, 35 and 36, Lindsey teaches, a system for utilizing at least one tender, comprising:

a storage device storing data which relates to the at least one tender (col. 4, lines 5-12) and a processing device transmitting information corresponding to the data (col. 4, lines 33-46).

Lindsey did not explicitly teach, wherein the at least one tender is provided for a complex multi-variable commodity. However Lindsey does implicitly teach, "the admit file 58 is written with data to note that a particular bale of cotton (commodity) was received at the warehouse, and the data indicating the date, time, and bale number, warehouse code and type of transaction (tender)" in col. 20, lines 3-9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least one tender is provided for a complex multi-variable commodity and to modify in Lindsey's system because such a modification would allow Lindsey to have "the buyer invoiced for the amount of the sale plus any additional agreed upon costs (contract) (col. 23, lines 21-22) for the commodity (bales of cotton).

As per claim 17 Lindsey also teaches, A system for utilizing at least one tender, comprising: wherein the at least one tender includes at least one of a term and a condition (col. 2, lines 47-50), and wherein the term and the condition are capable of being modified (col. 2, lines 51-67 and col. 3, lines 1-6).

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As per independent claim 35 this independent claim reciting "A set of instructions residing in a storage medium, the set of instructions capable of being executed by a processor to implement a method for utilizing at least one tender" is rejected for the similar rationale as given for claim 11 because the method steps of claim 35 correspond to the method steps of claim 11. Claim 35 claims a set of instruction residing on a storage medium and claim 11 claims a method with corresponding steps.

As per dependent claim 36 reciting "A set of instructions residing in a storage medium, the set of instructions capable of being executed by a processor to implement a method for utilizing at least one tender, the method comprising the steps." This dependent claim is rejected for the similar rationale given for claim 26. Claim 26 claims a method with steps corresponding to the set of instructions residing on a storage medium in claim 36.

As per claims 2 and 12, Lindsey teaches, The system according to claim 1, wherein the complex multi-variable commodity is a particular commodity whose price determination is based on a variation of a plurality of variable characteristics (col. 23, lines 50-67 and col. 24, lines 1-3).

As per claims 3 and 13, Lindsey teaches, The system according to claim 2, wherein at least one variable characteristic is a physical characteristic of the particular commodity ("Cotton is one such commodity which when compressed into a bale, has a certain quality, weight, etc. such that it maintains an individual identity throughout the

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trading process, until woven into a fabric, or otherwise used by a textile industry" -col. 1, lines 22-26).

As per claim 4, Lindsey teaches, the system according to claim 1, wherein the processing device executes a program on a remote device (col. 3, lines 59-65).

7. Claims 5-11, 14-16, 18-24, 27-29, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsey in view of (US 5,950,178) Borgato.

As per claims 5 and 20 The system according to claim 1, Lindsey did not teach, wherein the storage device includes a database storing data which is related to the at least one tender.

Borgato discloses, wherein the storage device includes a database storing data which is related to the at least one tender (col. 5, lines 25-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the storage device include a database storing data which is related to the at least one tender and to modify in Lindsey because such a modification would allow Lindsey to have a storage device that includes a database for various data relating to diamonds to be offered for sale as well as other data concerning those diamonds.

As per claims 6 and 21 The system according to claim 5, Lindsey and Borgato did not teach, wherein the database is a relational database, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the database to be a relational database and to modify in Lindsey and Borgato because such a modification would allow Lindsey and Borgato to store information in tables- rows and columns of data- and to conduct searches using data in the specified

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columns of one table to find additional data in another table which is old and well known in the database art.

As per claims 7, 14, 18, 27, The system according to claim 1, Lindsey did not teach, wherein the processing device enables a user to at least one of request and generate an exception to at least one of create and modify a term of the at least one tender.

Borgato discloses, the processing device enables a user to at least one of request and generate an exception to at least one of create and modify a term of the at least one tender (col. 7, lines 11-20 and lines 65-67, col. 8, lines 1-2, and col. 9, lines 10-16). It would have been obvious to one having ordinary skill in the art to have the processing device enable a user to at least one of request and generate an exception to at least one of create and modify a term of the at least one tender and to modify in Lindsey because such a modification would allow Lindsey to have a sales history (creation) of the selected category of the array display, the most recent sales price (modification) and a chart that reflects the new figures.

As per claims 8 and 22, the system according to claim 1, Lindsey did not teach, wherein the processing device: receives the data, analyzes the data, and transmits the information to a further processing device, wherein the information is transmitted in response to the received data. Borgato discloses, wherein the processing device: receives the data (col. 9, lines 1-10), analyzes the data (col. 9, lines 43-65), and transmits the information to a further processing device (col. 10, lines 3-15), wherein the information is transmitted in response to the received data (col. 10, lines 66-67 and

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col. 11, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device: receive the data, analyze the data, and transmit the information to a further processing device, wherein the information is transmitted in response to the received data and to modify in Lindsey because such a modification would allow Lindsey to have a means for displaying the data to be analyzed according to weight class, shape subclass, cut sub-subclass, clarity, color corresponding to the array category and inputting the data by selecting a button 82 to transmit the data to the host processor.

As per claims 9, 15, 23, and 28, the system according to claim 1, Lindsey did not teach, wherein the processing device at least one of transmits and receives the information electronically via the Internet.

Borgato discloses, the processing device is at least one of transmits and receives the information electronically via the Internet (col. 7, lines 6-16 and lines 40-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a processing device to be at least one of transmits and receives the information electronically via the Internet and to modify in Lindsey because such a modification would allow Lindsey's system to run Microsoft web browser Internet Explorer or higher and to have the communication link established by making a telephone connection or satellite link to the host processor 12.

As per claims 10, 16, 24, 29, and 34, the system according to claim 1, Lindsey did not teach, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices.

Borgato discloses, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices (col. 7, lines 6-16 and lines 40-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device to be at least one of transmits and receives information electronically via a network of further processing devices and to modify in Lindsey because such a modification would allow Lindsey to have a processor that runs Microsoft web browser Internet Explorer and a dial-up networking and display setting for receiving and transmitting data.

As per claim 11 A method for utilizing at least one tender, Lindsey did not teach, comprising the steps of receiving data for the at least one tender, the at least one tender being provided for a complex multi-variable commodity; and transmitting information corresponding to the data to a device.

Borgato discloses, receiving data for the at least one tender (col. 7, lines 29-33), the at least one tender being provided for a complex multi-variable commodity (col. 8, lines 1-12); and transmitting information corresponding to the data to a device (col. 8, lines 12-16).

As per claim 19 the system according to claim 17, Lindsey teaches, wherein the processing device executes a program on a remote device (col. 3, lines 59-65).

As per claim 31 Lindsey and Borgato did not teach, The method according to claim 30, wherein the interface is at least one of a text-based computerized menu and a graphical user interface-based computerized menu which provide menu options related to utilizing at least one of the at least one tender and the registration information of the

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user but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have an interface that is a text-based computerized menu and a graphical user interface-based computerized menu which provide menu options related to utilizing at least one of the at least one tender and the registration information of the user and to modify in Lindsey and Borgato because such a modification would allow Lindsey and Borgato's systems to have an environment that represents programs, files, and options by means of icons, menus, and dialog boxes on the screen and the user would be able to select and activate these options by pointing and clicking with a mouse or with the keyboard which is old and well known in the art of graphical user interfaces.

As per claim 32 Lindsey did not teach, The method according to claim 31, wherein the menu options include at least one of posting at least one tender, viewing the at least one tender, and bidding on the at least one tender. Borgato discloses, the menu options include at least one of posting at least one tender, viewing the at least one tender, and bidding on the at least one tender (col. 8, lines 60-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the menu options include at least one of posting at least one tender, viewing the at least one tender, and bidding on the at least one tender and to modify in Lindsey because such a modification would allow Lindsey to see in each category in the array a location to display an offer price, last transaction or sales price, and bid price.

As per claim 33 Lindsey did not teach, the method according to claim 30, wherein the data is at least one of received and transmitted electronically via the Internet.

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Borgato discloses, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices (col. 7, lines 6-16 and lines 40-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device to be at least one of transmits and receives information electronically via a network of further processing devices and to modify in Lindsey because such a modification would allow Lindsey to have a processor that runs Microsoft web browser Internet Explorer and a dial-up networking and display setting for receiving and transmitting data.

As per claim 34 the method according to claim 30, wherein the data is at least one of received and transmitted electronically via a network of processing devices.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,950,178) Borgato.

As per claim 30, Borgato teaches, a method for registering a user to utilize at least one tender on a networked information system, comprising the steps of: registering the user (col. 2, lines 35-52 and col. 7, lines 23-51); and providing an interface (col. 7, lines 51-67 and col. 8, lines 1-2), wherein the user utilizes at least one interface option (col. 8, lines 1-9), and wherein the at least one tender is provided for a complex multi-variable commodity (col. 8, lines 9-25).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiseman (US 5,168,446) disclosed spot commodity transactions.

Chou et al (US 6,240,400) disclosed an electronic trading system associated with a particular client site.

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for **OFFICIAL** communications and 703-746-5622 for **NON-OFFICIAL** communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read "E. Colbert". The signature is fluid and cursive, with a long horizontal stroke at the end.

E. Colbert

October 20, 2002